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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,586	06/08/2000	William W. Holmes IV	U6220/53569/NWJ-gasket	1012

23378 7590 10/06/2005

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EXAMINER

NGUYEN, XUAN LAN T

ART UNIT PAPER NUMBER

3683

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,586

Applicant(s)

HOLMES ET AL.

Examiner

Lan Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,11,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,11,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/19/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: approved drawings.

DETAILED ACTION

Drawings

1. The drawings were received on 7/18/05. These drawings are approved.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3, 11, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Guest (USP 5,603,530).

Re: claim 3, Guest shows a pipe joint in figure 11, as in the present invention, comprising: a male pipe 20, a female pipe 17, a compression gland 26 securable to the female second pipe portion, a gasket 25, 10, said gasket further comprising: a deformable body 25, a locking member 10 embedded in the deformable body (note that in column 1, lines 48-51, Guest states that a locking member embodied in an annular sealing element can be used for any arrangements in Guest's patent), wherein a portion of the locking member is positioned to engage the first pipe 20, as shown in figure 11 wherein locking member 10 is shown with lower portion biting into first pipe 20 and the upper portion of the locking member 10 biting into the second pipe 17 upon

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compression of the gland against said gasket; said locking member 10 resists the movement of first pipe in a direction outward of the second pipe by transferring a first portion of the extractive force to the gland via the deformable body 25 and the second portion of the extractive force directly to the second pipe 17, as shown in figure 11, which said first and said second portions of extractive force are each a magnitude less than the magnitude of the extractive force.

Re: claim 11, Guest further shows said gasket 25, 10 with a plurality of density regions adapted to influence the movement of said locking member, as shown in figure 11.

Re: claim 18, Guest further shows the interior surface of the second pipe portion, to which the second portion of the force is transferred, is disposed substantially parallel to the axis of the second pipe portion, as shown in figure 11.

Re: claim 17, Guest shows a restraining gasket in figure 15, as in the present invention, comprising: a male pipe 20, a female pipe 17, a tightenable compression gland 26, said gasket is snugly placed with the bell of the female pipe above, the male pipe beneath and the gland at the rear; wherein said gasket has a locking segment 10 engaging the male pipe 20 to form a rear-most angle which is acute in the extraction direction, as shown in figure 15, while other portions of the locking segment engage the female pipe and the gland at points not adjacent the male pipe, as shown in figure 15.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 3 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/685,914. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the copending application is broader and would have encompassed claim 3 of the instant application; and claim 1 of the copending application is broader with respect to the locking member when compared with claim 17 of the instant application.

6. Claims 3 and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/841,197. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 3 and 11 of the instant application are broader and would have encompassed claims 1 and 2 of the co-pending application.

7. Claims 3 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending

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Application No. 10/841,197. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 of the co-pending application is broader and would have encompassed claims 3 and 18 of the instant application.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Response to Arguments

8. Applicant's arguments filed 7/18/05 have been fully considered but they are not persuasive.

Applicant argues that the bead 26 of Guest is not a "compression gland securable to the female second pipe portion" because bead 26 of Guest is a weld bead, is not movable and is permanently affixed to the spigot, rather than being "securable to the second female pipe portion". It is believed that Applicant's argument is more specific than the claim language. Claim 3 does not comprise any limitation to exclude a weld bead to be a compression gland. Claim 3 does not require the compression gland to be moveable and not being permanently affixed to the spigot. Claim 3 simply states "**a compression gland** securable to the female second pipe portion" in lines 2-3; and "the locking member bites into the first pipe portion and the second pipe portion upon **compression of the gland** against said gasket" in lines 9-10. Guest shows in figure 11 that element 26 is in direct contact with the inner surface of female pipe portion 17. In figure 18, Guest provides another embodiment wherein two beads 31, 32 are provided. Guest teaches in column 3, lines 56-62, that "bead 32 is of larger diameter than bead 31

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to be a close fit in socket 24 to retain the seal in the socket when subject to pressure”.

One can see that when the weld bead is illustrated as directly contacting the female pipe portion in the Guest patent, it is intended to be a close fit and to secure the male pipe portion to the female pipe portion when subject to pressure. Hence, bead 26 of figure 11 of Guest meets the claimed limitations of “securable to the second female pipe portion” and “compression of the gland against said gasket” in claim 3. Claim 17 claims “a tightenable compression gland” in line 3 and “the compression gland” in line 5. It is maintained that element 26 of Guest meets the claimed limitation of a “tightenable compression gland” of claim 17 since it tightens and compresses the gasket 25 the same way as gland 11 of the instant invention tightens and compresses gasket 2.

Applicant further argues that Guest does not show seal 25 to comprise different density regions. As mentioned in the rejection of claim 3 above, Guest states that a locking member embodied in an annular sealing element can be used for any arrangements in Guest's patent, see column 1, lines 48-51. It is true that figure 11 shows locking member 10 to be a separate element from gasket 25. However, as stated above, element 10 can be embedded in gasket 25 for any embodiment taught in the Guest patent. As such, gasket 25 would have different density regions for rubber and for the locking ring 10.

The rejections are still deemed proper and are repeated above.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is (571) 272-7121. The examiner can normally be reached on M-F, 8 to 4:30.

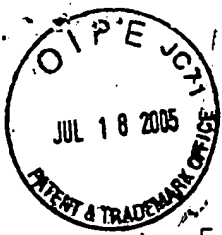
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lan Nguyen
Primary Examiner
Art Unit 3683

Lan Nguyen 9/22/05



Application No. 09/590,586
Amdt. Dated July 18, 2005
Reply to Office Action of 4/18/05
Replacement Sheet

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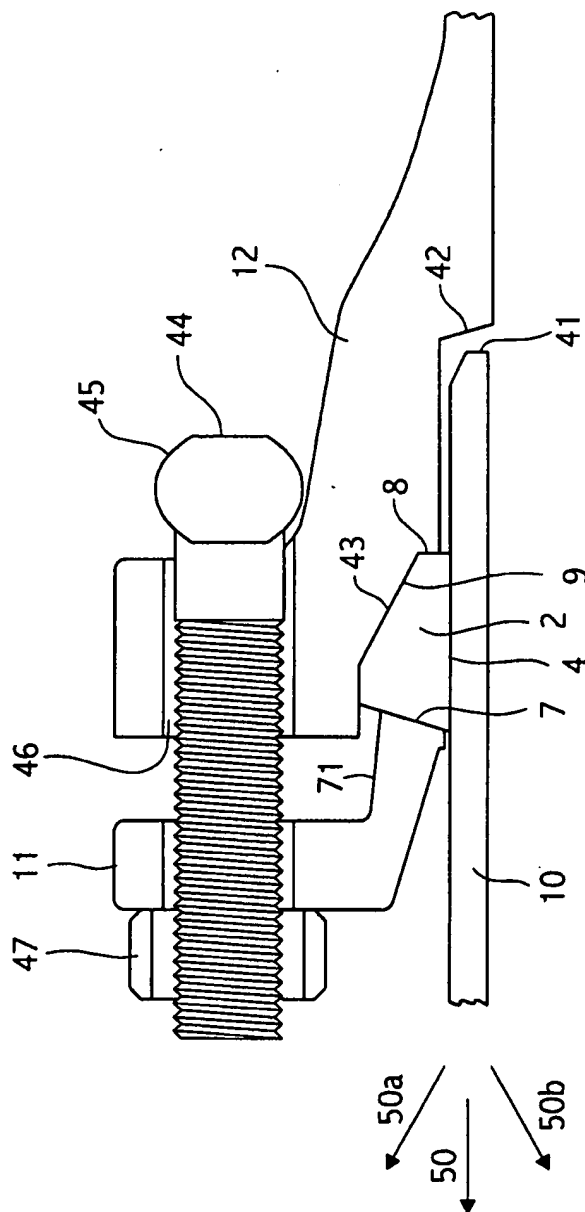


FIG. 1
PRIOR ART

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9/22/05



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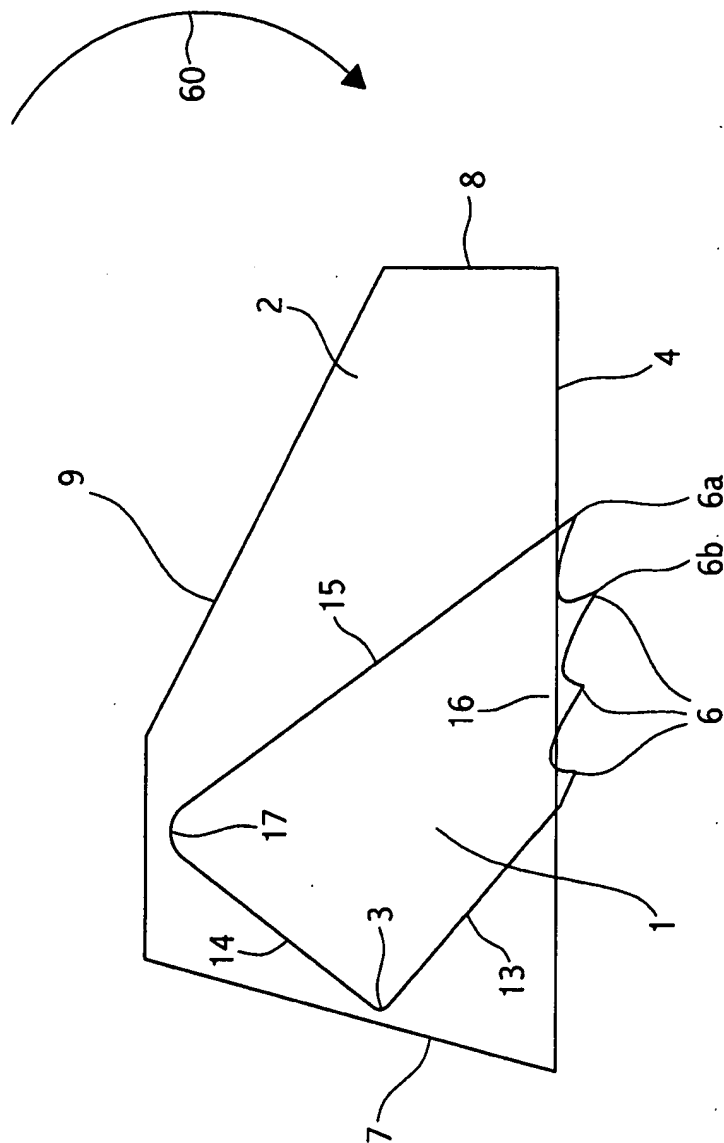
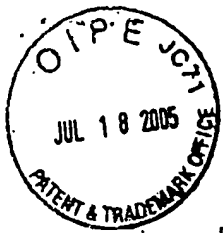


FIG. 2

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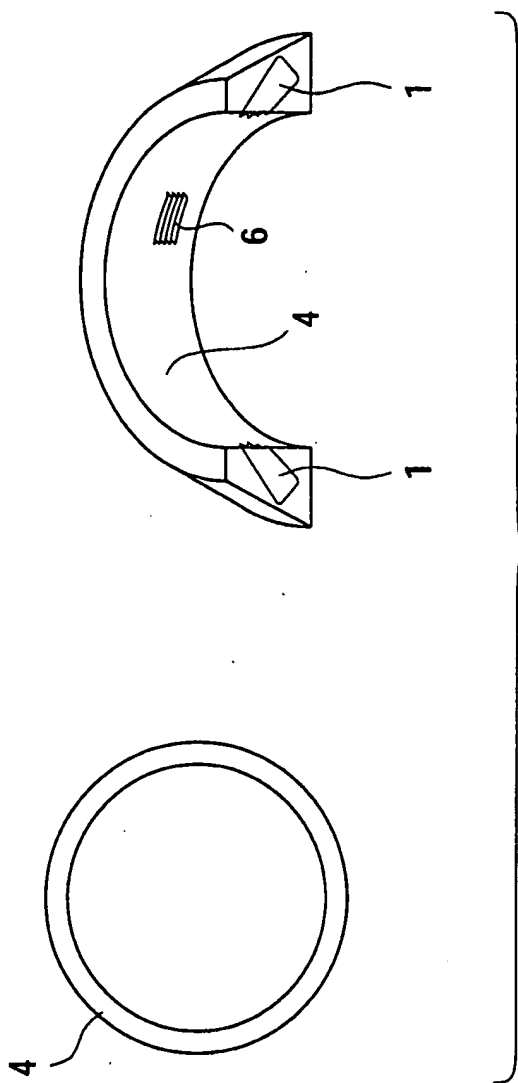


FIG. 3

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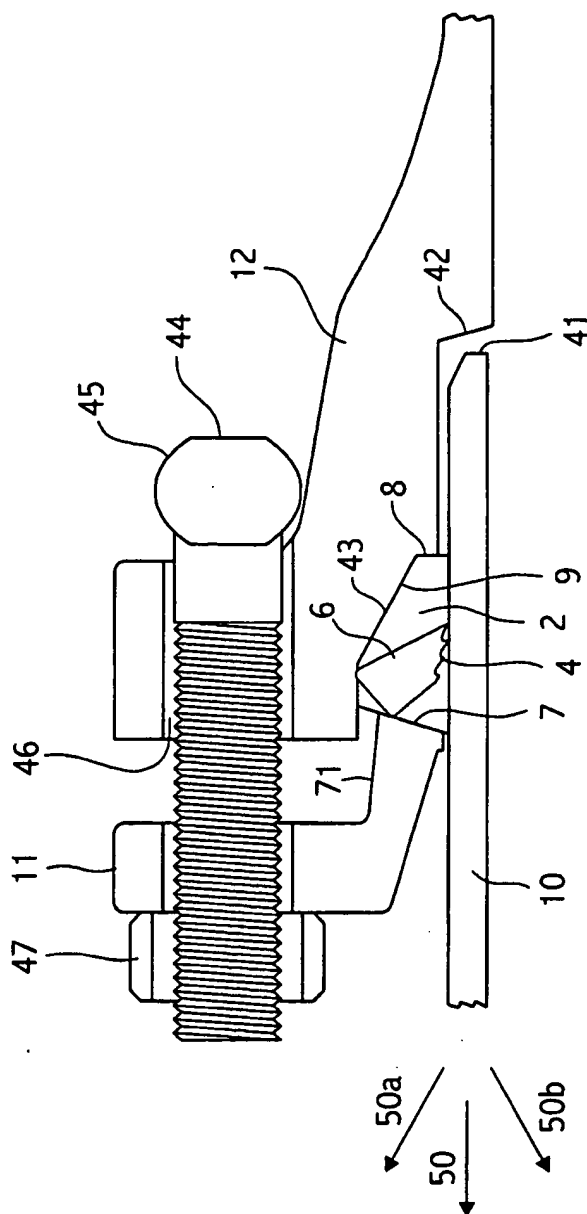


FIG. 4

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Replacement Sheet



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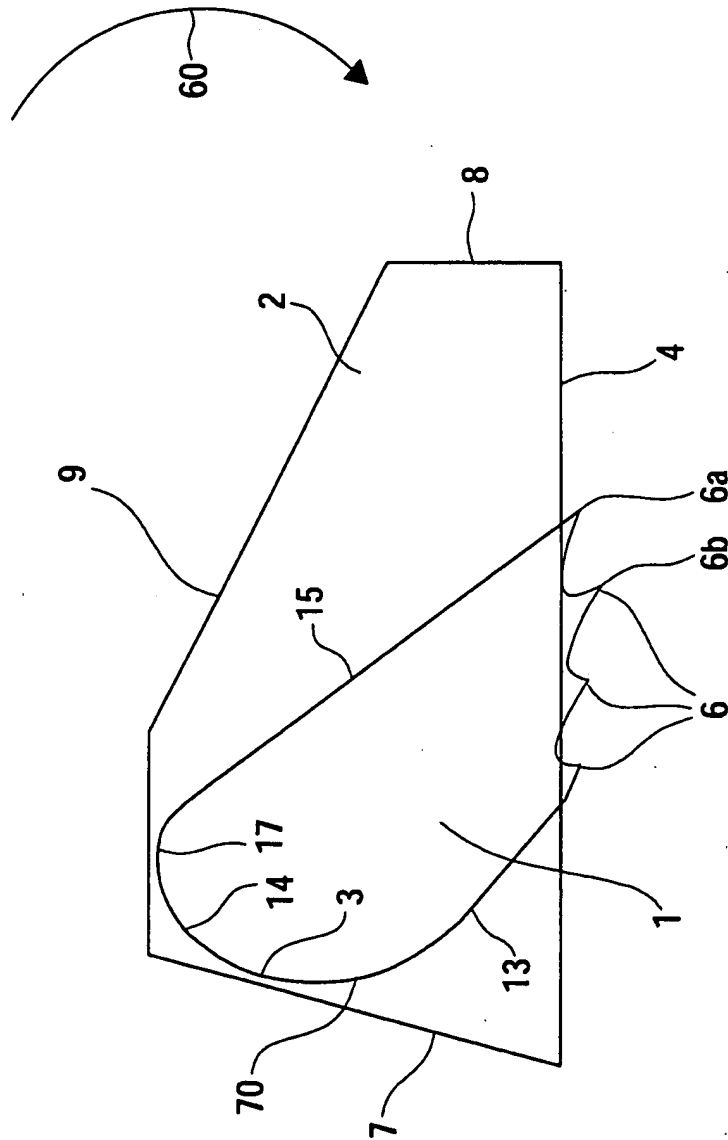


FIG. 6

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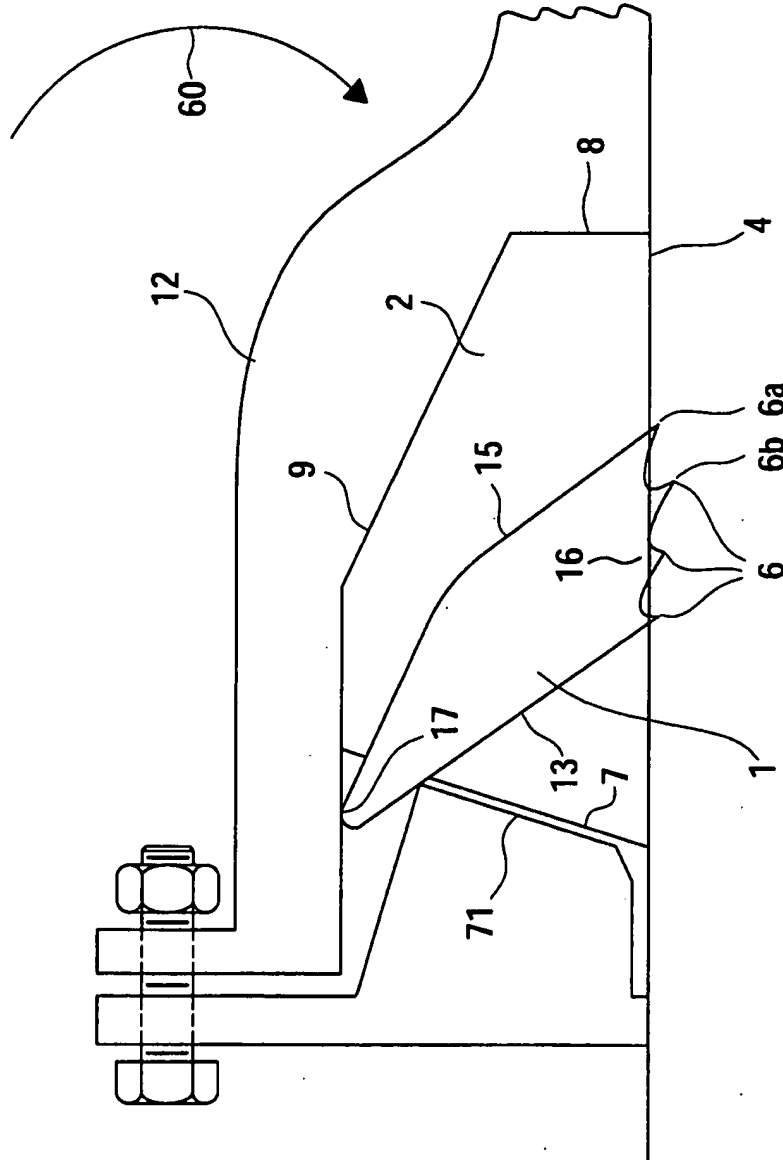


FIG. 7

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